

REMARKS

Claims 1, 2 and 28 have been amended. Claims 24-26 have been canceled without prejudice. Claims 29-32 have been added. Subsequent to the entry of the present amendment, claims 1-3 and 28-32 are pending and at issue. These amendments and additions add no new matter as the claim language is fully supported by the specification and original claims.

I. Rejections under 35 U.S.C. §102

Claims 1 and 2 rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Majewski. This rejection is moot in regard to claim 2, which now depends on new claim 29. Applicant respectfully traverses the rejection as it applies to claim 1.

The Office Action alleges that Majewski teaches two spaced piezoelectric actuators 20a, 20b surrounding an unrestricted tube 14 and coupled to a driver for sequential actuation (Figure 2).

A rejection of claims under 35 U.S.C. §102 is improper unless each and every element of the claimed subject matter is found, either expressly or inherently described, in a single prior art reference (Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987); MPEP §2131).

Applicant has amended claim 1 to state "the driver is connected to substantially simultaneously actuate said first and second actuators so as to dispense fluid droplets from said fluid chamber". The Office Action at page 3 states that Majewski teaches actuators "coupled to a driver for sequential actuation" and that "Majewski fails to teach substantially simultaneously firing". Accordingly, for at least the reasons discussed above, Majewski fails to teach each and every element of amended claim 1, namely, simultaneous actuation. Withdrawal of the rejection of claim 1 under 35 U.S.C. §102 is respectfully requested.

II. Rejections under 35 U.S.C. §103

A. Claim 3 is rejected under 35 U.S.C. §103(a) as allegedly being obvious over Majewski in view of claims 1-2 above. Applicant respectfully traverses the rejection.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify a reference or to combine the teachings of multiple references. Second, there must be a reasonable expectation of success. Third, the prior art must teach or suggest all of the recited claim limitations. Of course, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure.

The Office Action alleges it would have been obvious to size the device of Majewski in order to dispense desired volumes and to provide distal from the orifice as shown in Figure 6, resulting in a spacing of 10mm or more from the orifice of a large scale dispenser.

Applicant has shown above that claim 1, on which claim 3 depends, is allowable over Majewski because "Majewski fails to teach substantially simultaneously", which is required by the claim. In addition, claim 3 has been amended to clarify that the spacing of the actuators from the opening is done "to allow said fluid chamber to extend into sample wells". The tube in Majewski is not capable of being inserted into sample wells because of the plate 10 with orifice 26 at the end of the tubular member 14 would prevent insertion into a well (col. 4, lines 47-55, Fig. 1).

Applicant asserts that the combination suggested in the Office Action does not teach or suggest all of the claim limitations and that there is no reasonable expectation of success. Accordingly, for at least the reasons discussed above, Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. §103.

B. Claim 28 is rejected under 35 U.S.C. §103(a) as allegedly obvious over Majewski as applied to claims above, and further in view of WO 97/48557 (WO) and/or Iwasaki et al. Applicants respectfully traverse the rejection as it applies to the pending claims.

Claim 28 has been amended to depend on new claim 29, rendering this rejection moot. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 28 under 35 U.S.C. §103.

III. New claims

New claims 29-32 have been added to more fully describe the invention. The new claims are fully supported in the specification and no new matter has been added.

New claim 29 is the same as claim 1, except it further discloses a “fluid chamber comprising a cylindrical capillary made of glass or quartz” (see [0021]). The prior art does not disclose this. For example, Majewski discloses that “member 14 is characterized by substantial elasticity” (col. 4, lines 56-57). Glass or quartz are inherently non-elastic, so Majewski would not apply.

Claims 2 and 28 have been amended to depend on claim 29. Claim 30 is the same as claim 3. Claims 31 and 32 further define features of the cylindrical capillary and placement of the actuators. Support for these claims can be found in the specification, for example, see [0021] and [0024].

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Glenn C. Sasaki
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Conclusion

In view of the amendments and above remarks, it is submitted that the claims are in condition for allowance, and a notice to that effect is respectfully requested. The Examiner is invited to contact Applicant's undersigned representative if there are any questions relating to this application.

No fee is deemed necessary with the filing of this paper. However if any fees are due, the Commissioner is hereby authorized to charge any fees, or make any credits, to Deposit Account No. 07-1896 referencing the above-identified attorney docket number. A copy of the Transmittal Sheet is enclosed.

Respectfully submitted,

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